

REMARKS

The Official Action mailed September 8, 2005, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to January 8, 2006. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on July 19, 2000; and January 5, 2005. A further Information Disclosure Statement is submitted herewith and consideration of this Information Disclosure Statement is respectfully requested.

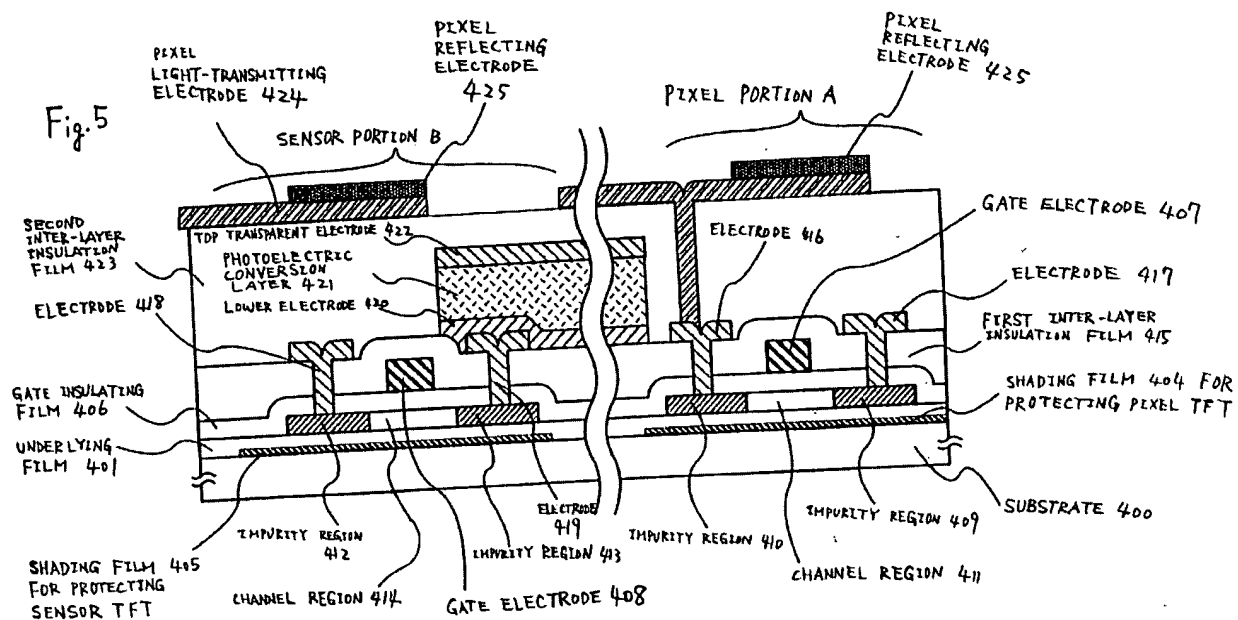
Claims 1-22, 29-34 and 38-67 were pending in the present application prior to the above amendment. The Applicants note with appreciation the allowance of claims 10, 11, 21 and 22 (page 12, Paper No. 20050829). Independent claims 38-43 have been amended to better recite the features of the present invention, and new dependent claims 68-73 have been added to recite additional protection to which the Applicants are entitled. Claims 1-9, 12-20 and 29-34 have been withdrawn from consideration by the Examiner (page 2, Paper No. 20050316). Accordingly, claims 10, 11, 21, 22 and 38-73 are currently elected, of which claims 10, 21 and 38-43 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 38, 40-44, 50, 52, 54, 56, 58-62 and 64-67 as anticipated by U.S. Patent No. 5,812,109 to Kaifu et al. The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicants have amended independent claims 38-43 to recite that a photo-electric conversion device comprises two electrodes and a photo-electric conversion layer interposed therebetween (see, e.g. Figure 5, reproduced below). Kaifu does not disclose the above-referenced features of the present invention, either explicitly or inherently.

Also, the Applicants have amended independent claims 38-43 to recite that an insulating film is provided between a pixel electrode and the photo-electric conversion device, which is supported in the present specification, for example, by the second inter-layer insulating film 423 shown in Figure 5 (reproduced below).



The Official Action asserts that Kaifu discloses that "an integral image recognition/display apparatus comprises: a plurality of pixel portions ... each having an active device, T11, ... and each having a pixel electrode ... comprising 10,000 angstrom thick layer of aluminum ... 6, and n-doped silicon ... 5, ... and a plurality of sensor portions ... wherein said sensor portion includes a photo-electric conversion device, 4" (citing Figures 4A and 4B, reproduced below).

The claims have also been amended to remove features which are not believed to be critical to the patentability of the claims. Specifically, the Applicants have deleted the features of independent claims 38-43 that were previously added in the *Amendment* filed June 24, 2005.

Paragraph 3 of the Official Action rejects claims 39, 45-49, 51, 53, 55, 57 and 63 as obvious based on the combination of Kaifu and U.S. Patent No. 5,585,817 to Itoh et

al. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

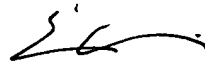
Please incorporate the arguments above with respect to the deficiencies in Kaifu. Itoh does not cure the deficiencies in Kaifu. The Official Action relies on Itoh to allegedly teach "a plurality of sensor portions disposed in matrix over an opposed substrate constituting a display panel, wherein said sensor portion has a photo-electric conversion device, and can read information by utilizing rays of light transmitting through said light-transmitting material when an external image is read" (page 9, Paper No. 20050829). However, Kaifu and Itoh, either alone or in combination, do not teach or suggest that the layer 4 of Kaifu (allegedly the photo-electric conversion device of the present invention) should comprise two electrodes and a photo-electric conversion layer interposed therebetween; or that a layer should be formed between layer 5/electrode 6

(allegedly the pixel electrode of the present invention) and layer 4. Since Kaifu and Itoh do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New dependent claims 68-73 have been added to recite additional protection to which the Applicants are entitled. For the reasons stated above and already of record, the Applicants respectfully submit that new claims 68-73 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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